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Alc (D) activating a bonus game acting in response to the bonus qualifying event to generate and display at least one binary outcome.

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REMARKS

Office Action

10 Applicants received a non-final office action dated August 27, 2002. In the office action, the Office rejected claims 1, 5, 13, 28, and 40 under 35 U.S.C. §112 and claims 1, 5, 7, 13, 20, 26, 28, 31, 35, 39, 46, and 50 under 35 U.S.C. §102 as being anticipated by Thompson. The Office also rejected claim 17 under 35 U.S.C. §103(a) as being unpatentable over Thompson, claims 2, 6, 8, 11-12, 14, 21-22, 29, 32-33, 37-38, 47, 16, 18-19, and 24-25 under 35 U.S.C. §103(a) as being unpatentable over Thompson in view of Gutknecht, and claims 3-4, 9-10, 15, 23, 27, 30, 34, 36, 40-45, 48-49, and 51-61 under 35 U.S.C. §103(a) as being unpatentable over Thompson in view of Gutknecht and in further view of Adams.

Interview

20 Applicants sincerely appreciate the courtesies extended by Examiner Carmen White during a telephonic interview conducted on December 3, 2002. Although no agreement was made regarding the allowability of the pending claims, Applicants explained to the examiner how the cited references lack certain elements of the claimed invention, including the binary outcome symbol.

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35 U.S.C. §112

Applicants have amended claims 1, 5, 13, and 28 to remove the lack of antecedent problems or to eliminate the use of the term "adapted to." Applicants have also amended claim 40 to remove the ambiguity the Examiner referred to in the office action. Applicants request the withdrawal of the 35 U.S.C. §112 rejections of claims 1, 5, 13, and 28.

35 U.S.C. §102

The Office rejected claims 1, 5, 7, 13, 20, 26, 28, 31, 35, 39, 46, and 50 under 35 U.S.C. §102 as being anticipated by Thompson. Applicants submit that claims 1, 5, 7, 13, 20, 26, 28, 31, 35, 39, 46, and 50 are patentable over Thompson because Thompson does not disclose each every element of these claims.

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindermann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984).

Independent claims 1, 7, 13, 20, 28, 31, 35, 40, 46, and 50 are rewritten below for the convenience of the examiner with emphasis on the points of distinction the Applicants will discuss below.

1. A gaming bonus device for use in a gaming system, comprising:

- a. a primary gaming device randomly generating a bonus qualifying event; and
- b. a bonus game acting in response to the bonus qualifying event, which generates and displays at least one **binary symbol outcome** entitling a player to a predefined payout issued to a player when the player wins depending upon the number of similar binary symbol outcomes displayed.

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7. A gaming bonus method for use in a gaming system comprising:

(A) allowing a player to play a game;

(B) producing a predefined bonus qualifying event; and

5 (C) activating a bonus game acting in response to the bonus qualifying event to generate and display three either/or **binary outcomes** entitling the player to a predefined payout issued to the player when the player wins depending upon the number of similar **binary outcomes** displayed.

10 13. A bonus gaming device for playing a bonus game by a player, comprising:

(A) a primary game that randomly generates a bonus qualifying event;

(B) a bonus game communicated with the primary game, the bonus game adapted to generate a plurality of either/or **binary symbol outcomes**;

15 (C) a selector button communicated with the bonus game, the selector button adapted to allow the player to select one of the either/or **binary symbol outcomes** as a winning outcome; and

(D) the bonus game displaying the either/or **binary symbol outcomes** and calculating a payout based upon the number of **binary symbol outcomes** that match the winning outcome selected by the player.

20 20. A method of playing a bonus game comprising:

(A) allowing a player to play a primary game;

(B) generating a bonus qualifying event, the primary game generating the bonus qualifying event;

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(C) starting a bonus game in response to the bonus qualifying event, the bonus game communicated with the primary game;

(D) selecting an either/or **binary symbol outcome** as a winning outcome;

(E) generating a plurality of either/or **binary symbol outcomes**;

5 (F) displaying the plurality of either/or **binary symbol outcomes**; and

(G) determining a payout based upon the selected winning outcome.

28. A bonus gaming device for playing a bonus game by a player, comprising:

10 (A) a primary gaming device, the primary gaming device being adapted to allow a player to play a game;

(B) a bonus gaming device, the bonus gaming device being adapted to generate a plurality of either/or **binary symbol outcomes**, the bonus gaming device adapted to award a prize based upon the number of **binary symbol outcomes** that match a winning outcome;

15 (C) an input device in communication with the bonus gaming device, the input device adapted to allow the player to select one of two outcomes as the winning outcome; and

(D) a display adapted to display the either/or **binary symbol outcomes**.

31. A method of playing a bonus game comprising:

20 (A) playing a primary game;

(B) generating a bonus qualifying event on the primary game;

(C) starting a bonus game;

(D) selecting a winning outcome;

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- (E) generating a plurality of **binary outcomes**;
- (F) displaying the plurality of **binary outcomes**; and
- (G) awarding a prize based upon the number of **binary outcomes** that match the selected winning outcome.

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35. A method of playing a game, comprising:

- (A) allowing a player to play a game;
 - (B) if a predefined event occurs, generating a plurality of **binary outcomes**; and
 - (C) if the plurality of **binary outcomes** is a predefined prize winning combination,
- 10 awarding a prize to a player.

40. A method of playing a game by a player, the method comprising:

- (a) allowing the player to play the game, the game awarding a prize to the player;
 - (b) allowing the player to select between receiving the prize or multiplying the prize by
- 15 an unknown multiplier to obtain a second prize;
- (c) awarding the prize to the player, if the player selects to receive the prize;
 - (d) allowing the player to select one of two **binary outcomes** resulting in a player selected **binary outcome**, if the player selects to multiply the prize by the unknown multiplier;
- 20 (e) selecting at least one **binary outcome**;
- (f) displaying the **binary outcome** to the player;
 - (g) determining the multiplier, the multiplier being equal to the number of **binary outcomes** that are the same as the selected binary outcome;
 - (h) multiplying the prize by a multiplier to obtain the second prize; and

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(i) awarding the second prize to the player.

46. A gaming bonus device for use in a gaming system, comprising:

a. a primary gaming device randomly generating a bonus qualifying event; and

b. a bonus game acting in response to the bonus qualifying event, which generates and displays a **binary symbol outcome**, the bonus game allowing a player to a select a winning **binary outcome**, the bonus game awarding a prize to the player when the **binary symbol outcome** matches the winning **binary outcome**.

50. A gaming bonus method for use in a gaming system comprising:

(A) allowing a player to play a game;

(B) producing a predefined bonus qualifying event;

(C) allowing the player to select a winning **binary outcome**; and

(D) activating a bonus game acting in response to the bonus qualifying event to generate and display at least one **binary outcome**.

Thompson does not disclose a binary symbol outcome display

At least one difference between independent claims 1, 7, 13, 20, 28, 31, 35, 40, 46, and 50 and Thompson is that the independent claims and their dependent claims, by virtue of claim dependency, claim the ability to display a binary symbol outcome. The dictionary meaning of the term "binary" is "something made of or based on two things or parts" (Merriam Webster's online dictionary, www.m-w.com, visited January 27, 2003). A plain meaning of the term "binary symbol outcome" is an outcome capable of being determined by one of two symbols.

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Binary symbol outcome is discussed in page 8, lines 9-14 of the specification, which states, "The outcomes are combinations of heads or tails, odds or evens, "Xs" or "Os," different colors or geometric shapes, entitling a player to a predefined payout when the player wins depending upon the number of similar binary outcomes elected and displayed. Although the following discussion
5 focuses on coins with head and tail outcomes, any binary outcome either/or symbols, colors, or shapes could be used instead, depending upon the theme desired."

Certain embodiments of the present invention, which incorporate a binary symbol outcome, have the ability to attract players because they provide a highly visible display device, or they use physical objects that are moveable and are used in combination with lights and
10 sounds. Once players are attracted to the gaming device, they tend to play longer because the display device enhances the stimulation and excitement experienced by players.

With regard to Thompson (EP 0 050 419 A1), Thompson appears to disclose a game apparatus that allows a player to play a game wherein the result of the game is determined based on the symbols on reels. It is well known in the art that a reel has a plurality of symbols and that
15 various combinations of reel symbols result in various possible outcomes. Therefore, the game outcome in Thompson is not based on one of two symbols.

It appears that Thompson allows the player to decide whether to gamble that a future random selection will produce a number from the series on the reel either higher or lower than that displayed on the display. The player may press buttons marked HIGHER or LOWER. See
20 page 11, lines 3-5 and lines 8-14. However, this feature does not disclose, teach, or suggest a binary symbol outcome. This feature appears to disclose an outcome based on guessing the relationship between a number and a number to be selected. This feature does not disclose an outcome based on binary symbols. Many different symbols may be displayed on display 28 and reels 11-14. It can be appreciated that an outcome based on two possible symbols, such as heads

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or tails, provides more excitement than an outcome based on *a relationship of two numbers*. The symbols provide an *instant manner* of notifying the player whether he won or not, whereas the outcome based on a relationship between two numbers *require the player to make calculations* or comparisons before being able to determine whether he won or not. Therefore, Thompson does not disclose a binary symbol outcome. Applicants request the withdrawal of all the rejections based on Thompson because Thompson does not disclose each and every limitation of the claims.

35 U.S.C. §103

10 Thompson in view of Gutknecht

The Office rejected claims 2, 6, 8, 11-12, 14, 21-22, 29, 32-33, 37-38, 47, 16, 18-19, and 24-25 under 35 U.S.C. §103(a) as being unpatentable over Thompson in view of Gutknecht. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, MPEP §2143.03. Applicants submit that claims 2, 6, 8, 11-12, 14, 21-22, 29, 32-33, 37-38, 47, 16, 18-19, and 24-25 are patentable for the following reason.

As discussed above, Thompson does not disclose, among other things, binary outcome symbols. With regard to Gutknecht (US Patent number 5,154,420), Gutknecht appears to disclose a game apparatus that allows a player to play a game wherein the result of the game is determined by one of FOUR positions of a coin. Figure 1 of Gutknecht shows the four positions as a head position 36, a tail position 38, a head-tails position 40, and a tails-head position 42. Gutknecht appears to disclose a quaternary game display and not binary game display. Therefore, Gutknecht does not disclose a binary symbol outcome.

Gutknecht further teaches away from using a binary symbol outcome as suggested by the

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following portions of the Gutknecht specification.

Motors contained within motor housing 90 and 96 are to be simultaneously actuated when button 46 is pressed. This in turn causes shaft 60 to be driven in one direction and shaft 72 to be driven in the opposite direction. It is to be noticed that pulley 82 is of a lesser diameter than pulley 64. This will cause the central member 54 to be revolved not only in the reverse direction relative to outer member 58, but also at a different speed and actually at a faster speed. **This is desireable since human beings, who would be playing the game, can become quite good at calculating exactly when a certain heads-tails combination might be displayed.** Therefore, the fact that central member 54 revolves at a much faster rate than outer member 58, it becomes almost impossible for a human being to make a precise guess as to what combination will be displayed. (Emphasis added) Col. 3, lines 34-50

Referring particularly to FIG. 7a, there is shown the front side of the coin with the word heads and the head of a human being along with a couple of olive branches. Referring particularly to FIG. 7d there is depicted the tail side of the coin with the word tails and an eagle shown on a perch. Besides the heads and tails configurations that can be obtained, the position of the outer member 58 could be in the heads position with the central member 54 being in the tails position as shown in FIG. 7b. Also, the outer member 58 could be in the tails configuration with the central member 54 in the heads configuration. **Therefore, there are four possibilities and only those four possibilities obtained when operating the gaming apparatus 10 of this invention.** (Emphasis added) Col. 3, lines 60 to Col. 4, lines 1-5

Applicants request the withdrawal of all the rejections based on Thompson in view of Gutknecht because the combination of Thompson and Gutknecht does not disclose, teach, or suggest each and every limitation of the claims.

Thompson in view of Gutknecht and in further view of Adams

The Office rejected claims 3-4, 9-10, 15, 23, 27, 30, 34, 36, 40-45, 48-49, and 51-61 under 35 U.S.C. §103(a) as being unpatentable over Thompson in view of Gutknecht and in further view of Adams. As discussed above, Thompson and Gutknecht does not teach, suggest, or disclose, among other things, binary outcome symbols. With regard to Adams (5,848,932), Adams appears to disclose a reel-based game apparatus and a wheel-based secondary game.

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One preferred embodiment of the present invention, illustrated in FIG. 1, comprises a primary gaming unit which comprises three rotatable wheels 10, each of which comprise a plurality of indicia on the periphery thereof...each reel 10 is designed to rotate and then stop in order to visually display at least one, preferably a number of indicia... when the reels 10 display at least one of a plurality of predetermined winning indicia or indicia sets then the player is provided with an opportunity for a secondary payout. Col. 3, lines 37-55.

The facing surface of bonus indicator 70 of FIG. 1 comprises four distinct areas bearing indicia of the bonus payout to the player. In the illustrated embodiment, the bonus indicator has areas indicating bonuses of \$25.00, \$50.00, \$100.00, and \$2,000.00. When bonus indicator 70 stops, an indicator (not shown) will indicate the area on the bonus wheel corresponding to the amounts of the bonus to be provided to the player. Col. 4, lines 9-16.

Nowhere in Adams can one find a suggestion or teaching of an outcome capable of being determined by one of two symbols. The outcome in Adams appears to depend on the reels displaying the predetermined winning indicia or indicia sets from a multitude of possible indicia and/or the bonus indicator stopping at one of the four areas indicating bonuses. Adams therefore does not disclose, teach, or suggest the ability to display a binary symbol outcome. Applicants request the withdrawal of all the rejections based on Thompson in view of Gutknecht and in further view of Adams because the combination of Thompson, Gutknecht, and Adams does not disclose, teach, or suggest each and every limitation of the claims.

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CONCLUSION

For all of the above reasons, the applicant submits that the present application is in condition for allowance. Applicants have not amended the claims to overcome patentability rejections. Applicants amended the claims to correct rejections based on lack of antecedent problems and ambiguity problems. If the examiner has any questions regarding the application or this response, the examiner is encouraged to call Applicants' attorney, Rolando J. Tong, at (775) 826-6160.

Respectfully submitted,



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VERSION WITH MARKINGS SHOWING CHANGES MADE

Please amend claims 1, 5, 13, 28, and 40 to the following:

1. (Amended Once) A gaming bonus device for use in a gaming system, comprising:

- 5 a. a primary gaming device randomly generating a bonus qualifying event; and
- b. a bonus game acting in response to the bonus qualifying event, which generates
 and displays at least one binary symbol outcome entitling a player to a predefined
 payout issued to a player when the player wins depending upon [the] a number of
 similar binary symbol outcomes displayed.

10 5. (Amended Once) A gaming bonus device according to claim 2, including an input device
 that allows the player [the] an opportunity to select a winning outcome.

13. (Amended Once) A bonus gaming device for playing a bonus game by a player,

15 comprising:

- (A) a primary game that randomly generates a bonus qualifying event;
- (B) a bonus game communicated with the primary game, the bonus game [adapted to]
 being configured to generate a plurality of either/or binary symbol outcomes;
- (C) a selector button communicated with the bonus game, the selector button [adapted to]
20 being configured to allow the player to select one of the either/or binary symbol
 outcomes as a winning outcome; and
- (D) the bonus game displaying the either/or binary symbol outcomes and calculating a
 payout based upon the number of binary symbol outcomes that match the winning
 outcome selected by the player.

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28. (Amended Once) A bonus gaming device for playing a bonus game by a player,
comprising:

(A) a primary gaming device, the primary gaming device being [adapted] configured to
allow a player to play a game;

5 (B) a bonus gaming device, the bonus gaming device being [adapted] configured to
generate a plurality of either/or binary symbol outcomes, the bonus gaming device
[adapted] being configured to award a prize based upon the number of binary symbol
outcomes that match a winning outcome;

10 (C) an input device in communication with the bonus gaming device, the input device
[adapted] being configured to allow the player to select one of two outcomes as the
winning outcome; and

(D) a display [adapted] configured to display the either/or binary symbol outcomes.

40. (Amended Once) A method of playing a game by a player, the method comprising:

15 (A) allowing the player to play the game, the game awarding a prize to the player;

(B) allowing the player to select between receiving the prize or multiplying the prize by
an unknown multiplier to obtain a second prize;

(C) awarding the prize to the player, if the player selects to receive the prize;

20 (D) allowing the player to select one of two binary outcomes resulting in a player
selected binary outcome, if the player selects to multiply the prize by the unknown
multiplier;

(E) selecting at least one binary outcome;

(F) displaying the binary outcome to the player;

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(G) determining the multiplier, the multiplier being [equal] proportional to the number of binary outcomes [that are the same as the selected binary outcome] matching the binary outcome the player selected;

(H) multiplying the prize by a multiplier to obtain the second prize; and

5 (I) awarding the second prize to the player.

50. (Amended Once) A gaming bonus method for use in a gaming system comprising:

(A) allowing a player to play a game;

(B) producing a predefined bonus qualifying event;

10 (C) allowing the player to select a winning binary outcome; and

(D) activating a bonus game acting in response to the bonus qualifying event to generate and display at least one binary outcome.